REMARKS

This responds to the Final Office Action mailed on January 8, 2009.

Claims 1, 3, 5-8, 10, 15, 24, 26, 28-31, 33, 38, 42, and 47-48 are amended, no claims are canceled, and no claims are added; as a result, claims 1-48 are now pending in this application.

§ *103 Rejection of the Claims*

Claims 1-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kari et al. (U.S. 6,154,745; hereinafter "Kari") in view of LeBlanc et al. (U.S. 6,236,365; hereinafter "LeBlanc").

The Applicants respectfully submit that the Office Action did not make out a *prima facie* case of obviousness for at least the following reasons. Even if combined, the cited references fail to teach or suggest all of the claimed elements of Applicants' claimed embodiments. Further, the cited references teach away from the currently claimed embodiments.

In examining claims under 35 U.S.C. § 103(a), it is necessary for the Examiner to establish a proper prima facie case of obviousness before rejecting a claim as required by the Board of Patent Appeals and Interferences (BPAI). Such a rejection cannot be made if there is no evidence or suggestion in a cited reference of a claimed configuration. Ex Parte Katoh et al., Appeal 20071460, Decided May 29, 2007. Further, it is improper to reject a claim when there is no suggestion to combine the teachings of the cited references, except from using the Applicants' invention as a template through hindsight reconstruction of the Applicants' claims. Ex Parte Crawford et al., Appeal 20062429, Decided May 30, 2007. Moreover, a patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727 *(2007)*. See also M.P.E.P. § 2142. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*See In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41 (2007)).

Moreover, the recent U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness. "A rationale to support a conclusion that a claim would have been obvious is that ***all the claimed elements were known*** in the prior art and one skilled in the art could have combined the elements as claimed by known methods ***with no change in their respective functions***, and ***the combination would have yielded nothing more than predictable results*** to one of ordinary skill in the art." (*See KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007)). Emphasis added.)

The U.S. Supreme Court recently held that rigid and mandatory application of the "teaching-suggestion-motivation," or TSM, test is incompatible with its precedents. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). The Court did not, however, discard the TSM test completely; it noted that its precedents show that an invention "composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* See also M.P.E.P. § 2142. The Court held that the TSM test must be applied flexibly, and take into account a number of factors "in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed." *Id.* at 1740-41. Despite this flexibility, however, the Court stated that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the way the claimed new invention does." *Id.* "To facilitate review, this analysis should be made explicit." *Id.* The obviousness rationale addressed in *KSR* was premised on combining elements known in the prior art. *Id.* at 1738-39. A parallel analysis applies, however, to a rejection premised on the obviousness of modifying a known composition to change its properties. The *KSR* Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some "apparent reason to combine the known elements in the fashion claimed." *Id.* at 1741. In the same way, when the prior art teaches away from the claimed solution as presented here, obviousness cannot be proven merely by showing that a known composition could have been modified by routine experimentation or solely on the expectation of success; it must be shown that those of ordinary skill in the art would have had some apparent reason to modify the known composition in a way that would result in the claimed composition.

Kari describes a method for transmission of information to the user, in which a search terminal is used for sending an information query, which is received and processed. Further in the method, information is searched for, and the retrieved information is transmitted to the search terminal. The information is received and displayed to the user by the search terminal. The information retrieval is arranged to be conducted at least partly on the basis of the location and/or travel route of the user. (Kari Abstract).

LeBlanc describes a location system for commercial wireless telecommunication infrastructures (CMRRs). The system is an end-to-end solution having one or more location systems for outputting requested locations of commercially available handsets or mobile stations based on, e.g. AMPS, NAMPS, CDMA or TDMA communication standards, for processing both local mobile station location requests and more global mobile station location requests via, e.g., Internet communication between a distributed network of location systems. The system uses a plurality of mobile station locating technologies including those based on: two-way TOA and TDOA; home base stations and distributed antenna provisioning. Further, the system can be modularly configured for use in location signaling environments ranging from urban, dense urban, suburban, rural, mountain to low traffic or isolated roadways. Accordingly, the system is useful for 911 emergency calls, tracking, routing, people and animal location including applications for confinement to and from certain areas.

Kari and LeBlanc are both related to cellular telephone and/or commercial wireless telecommunication technologies. One advantage that wireless telecommunication networks have is that the location of transmission towers used for transmission of wireless signals can be used to establish a geographic location of a particular wireless handset. The technology as presently described and claimed does not rely on the location of wireless transmission tower to associate a geographic location with a particular data network address. The embodiments as presently claimed include associating a geographic location with a network address in an internet protocol (IP) network. The embodiments as presently claimed also include performing at least one data collection operation in the IP network, the at least one data collection operation including performing a traceroute operation (e.g., see amended claims 1, 24, 47, and 48). Both Kari and LeBlanc do not relate to and do not suggest associating a geographic location with a network address in an IP network. Further, because both Kari and LeBlanc do not relate to and do not suggest associating a geographic location with a network address in an IP network, these references also do not describe or suggest performing at least one data collection operation in the IP network, the at least one data collection operation including performing a traceroute operation. As described in Kari and cited in the Office Action, Kari is based on, "properties of the GSM system (Global System for Mobile Communications)", (Kari, col. 2, lines 50-55) or, "from the GPS system or another satellite location system or via the positioning service of a mobile communication network" (Kari, col. 6, lines 15-24). As such, Kari does not teach or suggest, "collecting geographic location information, associated with a network address on an internet protocol (IP) network… and utilizing the geographic location information to associate a geographic location with the network address in the IP network." Additionally, both Kari and LeBlanc do not relate to and do not suggest performing at least one data collection operation in the IP network, the at least one data collection operation including performing a traceroute operation. Further, because Kari describes information retrieval conducted at least partly on the basis of the location and/or travel route of the user via the GSM, GPS, or other positioning service of a mobile communication network, Kari actively teaches away from the embodiments as presently claimed. Similarly, because LeBlanc is also related to wireless telecommunications infrastructures and teaches location information based on sources similar to Kari, LeBlanc also does not describe or suggest the embodiments as presently claimed.

Each of the pending claims include elements distinguished from Kari and LeBlanc as explained above, Thus, Kari alone or in combination with LeBlanc does not render obvious the presently claimed embodiments. The Applicants respectfully request withdrawal of the §103(a) rejections.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (408) 406-4855 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 16, 2009.

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